

REMARKS

Claims 80-97 are pending in the application.

Claims 80-97 have been rejected.

No Claims have been amended and reconsideration is respectfully requested.

I. OBJECTION TO SPECIFICATION

The Abstract has been objected to because the number of words exceeds 150. Applicant has amended the Abstract.

II. DOUBLE PATENTING REJECTION

Claims 80-93 were rejected on the ground of nonstatutory double patenting over U.S. Patent No. 6,597,700. Applicant assumes that this rejection is based on obviousness-type double patenting.

Applicant shall file a proper and timely terminal disclaimer when this rejection is the only remaining rejection/objection of the pending claims.

III. REJECTION UNDER 35 U.S.C. § 103

Claims 94-97 were rejected under 35 U.S.C. § 103(s) as being unpatentable over Sagawa (US Patent No. 5,222,064) in view of Jain (US Patent No. 5,737,601). The rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and

the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142. In making a rejection, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), viz., (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. In addition to these factual determinations, the examiner must also provide “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (*In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir 2006) (cited with approval in *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007)).

Neither of the cited references disclose “locally owned address entries” or “remotely owned address entries,” or distinguish between these two types of address entries - as described in Applicant's specification.

The Office Action argues that Sagawa teaches a first module with a local address database and a second module (remote from the first module) with its own local address database, and therefore, the local address database of the second module “must contain remotely owned address entries.” See, Office Action, page 5. Applicant submits that Sagawa does not disclose that the second module contains address entries that are “local” to the first module. Based on the Office Action's argument, the second module is described as containing “locally” owned address entries local to the second module – not address entries that are local to the first module (and termed a “remotely owned address entry”).

Jain describes the replication of “data” between databases – data described as inventory data (an inventory table: item and quantity on hand) and customer order data (order information associated with a customer’s order). See, Jain, Col. 5, lines 35-45. No disclosure of or delineation between locally owned addresses or remotely owned addresses is discussed. Thus, Jain is simply directed to the replication of data between two different databases, and there is no teaching or suggestion of a module that determines one of its locally owned address entry is obsolete, purges the locally owned address entry from the address database of the first module, and transmits a purge message to a second module for purging that address entry (as a “remotely owned address entry) in the second module. Therefore, Applicant respectfully submits there is no teaching or suggestion to combine Jain’s replication of inventory and customer order information (data) with Sagawa’s communication bridge apparatus. Even if combined, such combination would not produce or generate Applicant’s invention as claimed.

Accordingly, the Applicant respectfully requests withdrawal of the § 103(a) rejection of Claims 94-97.

IV. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

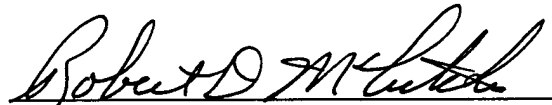
If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@munckbutrus.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Munck Butrus Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK BUTRUS, P.C.

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Robert D. McCutcheon
Registration No. 38,717

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3632 (direct dial)
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: *rmccutcheon@munckbutrus.com*